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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,670	08/16/2001	Achim Ansmann	H 2674A PCT/US	3804

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COGNIS CORPORATION  
2500 RENAISSANCE BLVD., SUITE 200  
GULPH MILLS, PA 19406

EXAMINER
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JONES, DAMERON

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/21/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/931,670

Applicant(s)

ANSMANN ET AL.

Examiner

D. L. Jones

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/16/01; 10/4/01; and 12/16/02.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) 14, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13, 15, 18 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of Paper No. 2, filed 8/16/01, wherein the specification was amended; a new abstract was submitted; claims 1-10 were canceled; and claims 11-22 were added.

**Note:** Claims 11-22 are pending.

### **APPLICANT'S INVENTION**

2. Applicant's invention is directed to compositions and processes thereof comprising a dialkyl ether of formula I, a cationic polymer, and an alkyl ether sulfate emulsifier as set forth in independent claims 11 and 20.

### **RESPONSE TO APPLICANT'S ELECTION**

3. Applicant's election with traverse of Group II (Claims 11-13, 15, and 18-22) in Paper No. 9, filed 12/16/02, is acknowledged. The traversal is on the grounds that all the compositions have the same mode of operation, perform the same function, and provide the same effect. This is found non-persuasive for reasons of record in the office action mailed 12/12/02, Paper No. 8. In particular, the invention are distinct because each group requires a different emulsifier that is structurally different from one another. Thus, a search of the prior art for one group of compositions would neither anticipate nor render obvious the compositions of another group. Furthermore, it should be noted that the Examiner respectfully requested that Applicant elect a single disclosed species for search purposes only. Hence, the search was not limited to the elected species, but

expanded over the full scope of Applicant's elected group. The restriction requirement is still deemed proper and is therefore made FINAL.

**Note:** Applicant is respectfully requested to cancel all subject matter directed to the non-elected inventions. It should be noted that the search was not extended beyond Group II.

#### **WITHDRAWN CLAIMS**

4. Claims 14, 16, and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

#### **DOUBLE PATENTING**

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 1616

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 11-13, 15, 18, and 20-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, and 9-13 of U.S. Patent No. 6,309,628 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a composition and process thereof comprising an alkyl ether sulfate, a polymer, and a dialkyl ether corresponding to formula I. The claims differ in that the patented claims specifically disclose that the polymer is a silicone compound.

## **112 REJECTION**

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22: The claim as written is ambiguous because it depends upon itself.

The claim was examined as if it read upon claim 20.

### **CLAIM OBJECTIONS**

9. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **SPECIFICATION**

10. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a divisional of Application No. 09/308,084, filed 5/12/99." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

### **PRIORITY DOCUMENT**

11. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 11/4/96. It is noted, however, that applicant has not filed a certified copy of the German application (No. 19646869.8) as required by 35 U.S.C. 119(b).

**COMMENTS/NOTES**

12. It is noted that no prior art has been cited against elected Group II. Thus, the claims as they relate to Group II only are allowable over the prior art of record. However, Applicant MUST address and overcome the 112 and double patenting rejections above. In particular, the claims are distinguished of the prior art of record because the prior art neither anticipates nor renders obvious a composition as set forth in independent claims 11 and 20 wherein the emulsifier is an alkyl ether sulfate. Furthermore, it should be noted that while the Examiner requested that a species be elected for search purposes, the search has been expanded over the full scope of Group II.

13. The document (US Patent No. 6,365,168 B1) appearing on the PTO-892 and not cited in a rejection is Applicant's own work which is the parent of the divisional application cited on the bibliography page of the instant invention.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers

Art Unit: 1616

for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
D. L. Jones  
Primary Examiner  
Art Unit 1616

February 14, 2003